

REMARKS

In the Office Action, the Examiner rejected claims 1-26. By this paper, Applicants submit a Rule 131 Declaration of inventor John R. Grady and associated Exhibits A, B, C, and D to swear behind Potter et al. (U.S. Patent No. 6,533,587 B1) and Hasegawa et al. (U.S. Patent No. 6,312,273 B1). Applicants respectfully request reconsideration and allowance of the pending claims 1-26 in view of the enclosed evidence and the following remarks.

Claim Objections

In the Office Action, the Examiner objected to the structural relationships recited in claim 5, specifically stating:

Claim 5 is objected to as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. The claim refers to a stationary member but does not mention where this member is positioned. It is unclear how the claim language supports the recitation that the installation is facilitated.

Paper 2, page 2. Applicants respectfully traverse this objection.

Applicants emphasize that it is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result. See M.P.E.P. § 2172.01. The Examiner is also reminded not to equate breadth of a claim with indefiniteness. *In re Miller*, 441 F.2d 689, 169 U.S.P.Q 597 (CCPA 1971).

Claim 5 recites a gripping member that includes “a recess sized to engage a *corresponding, stationary* feature to facilitate installation as the lever system is *pivoted*.” Applicants stress that the foregoing recitation clearly indicates a pivotable relationship, which can function with different positions of the “corresponding, stationary feature.” It is not essential to an understanding of the claim to specify the precise location of the “corresponding, stationary feature.” Accordingly, Applicants submit that the foregoing claim does in fact particularly point out and distinctly claim the desired subject matter.

For these reasons, Applicants respectfully request the Examiner withdraw the objection to claim 5.

Claim Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 9 and 20 under 35 U.S.C. § 102(e) as anticipated by Potter et al. (U.S. Patent No. 6,533,587 B1).

In view of the earlier date of invention of the subject matter disclosed and claimed in the present application, Applicants have chosen to remove both the Potter et al. and Hasegawa et al. references pursuant to 37 C.F.R. § 1.131. Under Rule 131, an applicant may overcome a prior art rejection by filing an appropriate declaration that establishes invention of the claimed subject matter by the applicant prior to the effective date of the reference relied upon in the rejection. Prior invention may be shown either (1) by proving an actual reduction to practice prior to the effective date of the reference or (2) by proving conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the effective date of the reference to an actual or constructive reduction to practice.

Here, Applicants submit the enclosed Rule 131 declaration signed by John R. Grady, co-inventor of record in the present application, to demonstrate conception and actual reduction to practice of the claimed invention before the effective date of the Potter et al. reference. In addition, the enclosed Rule 131 Declaration demonstrates conception prior to the effective date of the Hasegawa et al. reference coupled with due diligence prior to its effective date until subsequent reduction to practice. Specifically, in paragraph 3 of the attached Declaration, Applicant/Inventor Grady declares that “the subject matter disclosed and claimed in the present application was conceived at least as early as August 19, 1999.” As evidence of this conception, Applicant/Inventor Grady further declares that Exhibits A and B, which are dated August 19 and 31 of 1999, “clearly illustrate a PCI riser card assembly having a riser card and a pair of opposite card connectors,” as set forth in the present claims. Thus, the present technique was *conceived at least as early as August 1999*.

As indicated on the face of the references, the effective date of the Potter et al. reference is no earlier than July 5, 2000, and the effective date of the Hasegawa et al. reference is no earlier than September 9, 1999.

Turning to diligence and reduction to practice, the enclosed Rule 131 Declaration further indicates an actual reduction to practice at least as early as November 18, 1999 and, also, diligence from just prior to the effective date of Hasegawa et al. until the actual reduction to practice. In paragraph 4 of the Rule 131 Declaration, Applicant/Inventor Grady declares that, after conception, we were “diligent in reducing the concept to practice,” as “evidenced by a Mechanical Plan of Record created on August 30, 1999 and signed electronically on September 1, 1999.” *See* Exhibit C. For example, the Mechanical Plan of Record includes a Mechanical Schedule, which lists High Confidence Dates of 9/21 and 11/2 for Mechanical Prototypes A and B, respectively. *See id.* In paragraph 5, Applicant/Inventor Grady further declares that, “in close correspondence with the forgoing Mechanical Schedule, we reduced the concept to practice no later than November 18, 1999,” as evidenced by tooling drawings “faxed on November 18, 1999 after successful creation and testing of a prototype of the PCI riser board.” *See* Exhibit D.

Turning now to the references, the Potter et al. reference has an effective date of no earlier than July 5, 2000, which is clearly after the foregoing actual reduction to practice of at least as early as November 18, 1999. Accordingly, the Applicants swear behind Potter et al. and request that the Examiner remove Potter et al. from consideration.

Regarding the Hasegawa et al. reference, the Applicants note that the claimed invention was conceived at least as early as August 1999, which is prior to the effective date of no earlier than September 9, 1999 for Hasegawa et al., followed by due diligence prior to this effective date up until the actual reduction to practice at least as early as November 18, 1999. Accordingly, the Applicants swear behind Hasegawa et al. and request that the Examiner remove Hasegawa et al. from consideration.

Upon removal of these references, Applicants respectfully request the Examiner withdraw the rejection of claims 9 and 20 under 35 U.S.C. § 102.

Claim Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-4 and 6 under 35 U.S.C. § 103(a) as unpatentable over Steffes et al. (U.S. Patent No. 5,338,214) in view of Murphy (U.S. Patent No. 4,979,075); claims 4-8 as unpatentable over Steffes et al. and Murphy in further view of Hasegawa et al. (U.S. Patent No. 6,312,273 B1); claims 9-13 and 21-25 as unpatentable over Potter et al. in view of Steffes et al.; and claims 14-19 and 25-26 as unpatentable over Potter et al. in view of Steffes et al. and further in view of Hasegawa et al. Applicants first reiterate the removal of Potter et al. and Hasegawa et al. pursuant to the Rule 131 Declaration discussed in detail above. Accordingly, the only remaining references are Steffes et al. and Murphy, which are not properly combinable as discussed in detail below. For these reasons, the Applicants traverse the foregoing rejections.

Legal Precedent

Applicants respectfully traverse these rejections. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). If the Examiner combines the teachings of the prior art to produce the claimed invention, a *prima facie* case of obviousness cannot be established absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the

obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Background

In electronics such as servers, it has become increasingly difficult to package all the desired components within the chassis. As a result, certain components may be sacrificially left out of the chassis or, alternatively, a larger chassis may be used to accommodate the components. To address these problems, the subject matter disclosed and claimed in the present application comprises a space saving PCI card assembly that fits at least two PCI cards in a low profile device, such as a 1U chassis.

Claims

Turning to the claims, independent claim 1 recites, *inter alia*, “the second *PCI card* extending from the PCI riser card in a direction *opposite* that of the *first PCI card*; and a lever system to move the framework *between an install position and an eject position*.” Independent claim 9 recites, *inter alia*, “a PCI card assembly having a framework sized to fit within the chassis, the framework being configured to receive a pair of *opposed PCI cards*.” Finally, independent claim 20 recites, *inter alia*, “mounting a pair of PCI cards to a PCI riser card disposed therebetween.”

Omitted Features

In contrast to the above claim features, the Steffes et al. merely teaches cards 22 disposed on the *same side* of a riser card, as admitted by the Examiner. *See* Paper 2, page 4. In fact, Steffes et al. teach a latch and removal means on the other side from the cards 22, such that the cards cannot be disposed on opposite sides as recited in the instant claims. *See* col. 3, lines 7-11; col. 8, lines 18-22. In the Office Action, the Examiner relied on Murphy in attempts to obviate this deficiency of Steffes et al. However, as discussed below, the Murphy reference cannot be used to obviate the deficiency of Steffes et al., because the cited references are not properly combinable.

No Suggestion or Motivation to Combine

First, the Applicants stress the lack of any motivation or suggestion to combine Steffes et al. with Murphy. The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, U.S.P.Q.2d. 1430 (Fed. Cir. 2002). The mere fact that a worker in the art could rearrange or interchange the parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. See M.P.E.P. § 2144.04 VI (C). Accordingly, Applicants challenge the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references.

Teaching Away

Second, the Applicants submit that any evidence of such motivation or suggestion to combine the cited references cannot stand against the clear teaching away apparent in the cited references.

A prior art reference must be considered in its entirety; i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); see M.P.E.P. § 2143.01. Finally, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Turning now to the cited references, the combination of Murphy and Steffes et al. is clearly unworkable. First, if cards were disposed on both sides of the elongated frontal side wall 28 in Steffes et al., the lever 108 would not function for its intended purpose. See Fig. 8;

col. 8, line 47 – col. 8, line 22. Accordingly, a combination of these references would clearly change the principle of operation of both Steffes et al. and of Murphy.

For these reasons, legal precedent clearly precludes the Examiner's proposed combination of Steffes et al. with Murphy.

Request Withdrawal of Rejections

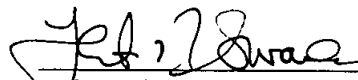
As discussed previously, in view of the earlier date of invention of the subject matter disclosed and claimed in the present application, Applicants have chosen to remove both the Potter et al. and Hasegawa et al. references pursuant to 37 C.F.R. § 1.131. In addition, for the reasons provided above, the Steffes et al. and Murphy references are not properly combinable. Given that neither Steffes et al. nor Murphy independently teaches the claimed features, all of the Examiner's rejection must fall. Accordingly, Applicants respectfully request the Examiner withdraw all rejections under 35 U.S.C. § 103.

Conclusion

In view of the enclosed evidence and the foregoing remarks, Applicants respectfully request allowance of all pending claims 1-26. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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